

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1 and 2 are pending in the application, with claim 1 being the independent claim. Claims 1 and 2 have been amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Obviousness-Type Double Patenting Rejections

The Examiner has provisionally rejected claims 1 and 2 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,615,208. Applicants have filed herewith a terminal disclaimer over U.S. Patent No. 6,615,208, thereby rendering this rejection moot. Accordingly, Applicants respectfully request that the rejection of claims 1 and 2 for obviousness-type double patenting be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 101

The Examiner has rejected claims 1 and 2 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants have amended these claims to make clear that the various method steps are implemented in a computer system. Applicants respectfully submit that these amendments fully address the Examiner's concern that the claimed invention "does not recite the use of nor incorporate any technology in carrying out the recited method steps." Accordingly, Applicants request that the rejections of claims 1 and 2 under 35 U.S.C. § 101 be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,266,649 to Linden *et al.* ("Linden") in view of U.S. Patent Application Publication No. 2001/0014868 A1 to Herz *et al.* ("Herz"). For the reasons set forth below, Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness of claim 1 based on the combination of Linden and Herz. As will be explained in more detail below, this is because (a) the combination of Linden and Herz does not teach each and every limitation of independent claim 1; and (b) the Examiner has not articulated a legally sufficient motivation to combine Linden and Herz.

The Combination of Linden and Herz Does Not Teach or Suggest Each and Every Limitation of Claim 1

Claim 1 recites a method for automatically recommending textual items stored in a database to a user of a computer-implemented service. The recited method includes the steps of:

storing in a computer-readable memory selections of textual items entered by the user,

responsive to a new textual item being added to the database, applying a latent semantic algorithm to the textual items, including the new textual item, and the stored user selections in a computer to establish a conceptual similarity among the textual items; and

providing a computer-generated alert to the user about the new textual item whenever the conceptual similarity between the new textual item and the stored user selections is within a prescribed value with reference to the conceptual similarity.

Neither Linden nor Herz teach establishing a conceptual similarity among textual items "*responsive to a new textual item being added to the database*" as recited by claim

1. The Examiner asserts that this feature is taught at column 2, lines 61-67 and column 3, lines 1-6 of Linden. However, the cited text does not teach or suggest this feature. Instead, in Linden, item-to-item similarity mappings are generated either (a) in response to an on-line action of a user (*see* Linden, column 10, lines 13-14), or (b) generated automatically on a periodic basis (*see* Linden, column 10, lines 28-37). Applicants cannot find any teaching or suggestion in either Linden or Herz to establishing a conceptual similarity "*responsive to a new textual item being added to the database*" as recited in claim 1. The recited feature provides the benefit of allowing user notifications to be generated soon after new textual items are added to a database.

Furthermore, neither Linden nor Herz teach or suggest "applying a latent semantic algorithm to the textual items, including the new textual item, and the stored user selections in a computer to establish a conceptual similarity among the textual items" as recited in independent claim 1. The Examiner has already conceded that Linden does not disclose the application of a latent semantic algorithm. *See* Office Action at pp. 4-5. While Herz does refer to latent semantic indexing as a method for calculating word scores, it does so only in the context of identifying similarities between abstract "user profiles" and "offer profiles"¹, rather than between textual items that can be recommended to a user as recited in claim 1.

There Is No Motivation to Combine the References

To make a *prima facie* case of obviousness, the Examiner must establish a suggestion or motivation to combine the reference teachings. (MPEP § 2142.) "When the motivation to combine the teachings of the references is not immediately apparent, it

¹ In Herz, a "profile" is defined as system-accumulated set of attributes pertaining to a user or offer. As explained in Herz:

[S]hoppers can be profiled in terms of both their demographic characteristics (age, income, family structure, ethnicity, and the like) and their past shopping behavior (products purchased, length of time since last purchase, allocation of browsing time, attention span, price sensitivity, interest in detailed features, impulse buys, use of coupons, and the like). Offers can be profiled as well. Possible attributes for offers include the newness and advertised duration of the offer, the type of product or service being offered, the product's brand name and features, the shoppers who tend to buy the product, other products frequently bought on the same shopping trip, the sales pitch, the price and terms of payment, any discounts provided, and the relative attributes of competing offers.

See Herz, paragraph [0005]. Herz further teaches that promotions are selected based on a identifying similarities between "user profiles" and "offer profiles":

[P]rediction of shopper U's likely interest can be made by considering the past interest of shoppers whose profiles are similar to U's in offers whose profiles are similar to X's, provided that the past interest has been determined by passive or active feedback.

See Herz, paragraph [0138].

is the duty of the examiner to explain why the combination of the teachings is proper." (*Id.* citing *Ex parte Skinner*, 2 USPQ2d 1788 (BPAI 1986).) It is important that the motivation to combine references be established with objective evidence and specific factual findings with respect to the references. (*Id.* § 2143.01; citing *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002).) Applicants find no such evidence, and the Examiner has not met the above established burden.

Applicants cannot find any express or implied motivation to combine the cited references. Linden's recommendations service identifies items to recommend based on a mapping table that stores items which have been deemed similar based at least on "correlations between known interests of users in particular items" in which "items A and B are [deemed] similar because a relatively large portion of the user that purchased item A also bought item B", whereas Herz teaches the identification of recommended items based on the comparison of both "user profiles" and "offer profiles". Because these are very different approaches, it is not clear how they could be combined to result in the invention of claim 1, let alone what motivation there would be to do so.

The Examiner's stated rationale for the alleged motivation to combine the references is insufficient. The Examiner's single sentence supporting the motivation to combine is essentially a statement that a latent semantic algorithm can be applied to "additional text". The Examiner makes no factual findings with respect to the references; nor does the Examiner even cite to the references. Applicants respectfully assert that the Examiner's single conclusory statement is insufficient to establish a *prima facie* motivation to combine, and is the result of impermissible hindsight.

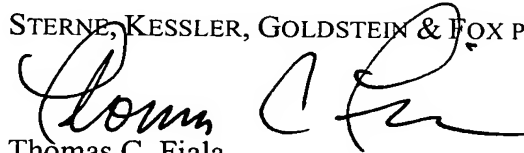
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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